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EXAMINER

SAVAGE, MATTHEW O

ART UNIT PAPER NUMBER

1723

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/052,159

Applicant(s)

DAVIS, STEVEN S.

Examiner

Matthew O Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 7-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to a filter plate, classified in class 210, subclass 224.
- II. Claims 7-12, drawn to wear elements, classified in class 285, subclass 16.
- III. Claims 13-17, drawn to wear elements, classified in class 285, subclass 16.
- IV. Claims 18 and 19, drawn to a wear element, classified in class 285, subclass 16.

Inventions I and II together with III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the filtrate outlet insert having an opening as required by group II (see claim 11) and group IV (see claim 18, the particulars of the filtrate outlet insert having a bore as required by group III (see claim 17). The subcombination has separate utility such as for use in a filter plate not having any feed ports.

Inventions II and III together with IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the filtrate channel having a first closed end and a second closed end as required by group III (see claim 16), or the particulars of the insert being sized and configured for receipt with a pre-formed filtrate outlet channel as required by group IV (see claim 18). The subcombinations have separate utility such as for use in a filter plate not having a wear plate.

Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the insert being sized and configured for receipt with a pre-formed filtrate outlet channel as required by group IV (see claim 18). The subcombination has separate utility such as for use in a filter plate not having a channel insert.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Julie K. Morriss on 5-9-03 a provisional election was made with traverse to prosecute the invention of group I, claims 1-6.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 7-19 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The drawings are objected to because: reference number 62 is missing from FIG. 4; reference number 82 should be changed to 80 in FIG. 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Heaton.

With respect to claim 1, Heaton discloses a filter plate (e.g., the combination of elements 31-34, see FIG. 6) including a feed port (see lines 109-112 of page 1) and a passageway for the egress of filtrate from the filter plate (see lines 105-109 of page 1, replaceable wear elements positioned on the plate in proximity to the passageway and providing at least one filtrate opening and channel to direct filtrate flow from the filter

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plate (e.g., the passageway 39 shown in FIG. 6, and the passageways 47 and 60 shown in FIG. 8).

As to claim 2, Heaton discloses at least one replaceable wear plate 31, at least one filtrate opening 39 formed through the replaceable wear plate, and a replaceable filtrate channel insert (e.g., parts 33, 34, or part 46) having at least one opening (e.g., the opening 47 through parts 33, 34, or the opening associated with part 46, see FIG. 8).

Concerning claim 3, Heaton discloses a replaceable filtrate outlet insert 46 positioned to be in fluid communication with the filtrate channel insert 33, 34 to redirect the direction of flow of filtrate from the filter plate.

As to claim 6, Heaton discloses wear elements 31 formed of material more wear resistant than the filter plate 33, 34 (e.g., when parts 31 are formed of metal and parts 33, 34 are formed of lighter plastics material, see lines 115-124 of page 1).

Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

*M. Savage*  
Matthew O Savage  
Primary Examiner  
Art Unit 1723

mos  
May 12, 2003